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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/522,221

01/31/2006

Gunter Schubert

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PROSKAUER ROSE LLP
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BOSTON, MA 02110

EXAMINER

FREEMAN, JOHN D

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

09/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/522,221	Applicant(s) SCHUBERT ET AL.	
	Examiner John Freeman	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/10/08 & 5/27/08.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The substitute specification filed 10 April 2008 has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because the substitute specification introduces new matter. Specifically, Applicant's replacement of the term "polyethylene of increased density" with "high density polyethylene," and the replacement of "sealing foil" with the term "composite film for sealing" constitute new matter.
2. Regarding the replacement of "polyethylene of increased density" with "high density polyethylene," Applicant argues this was a result of a translation error. However, no evidence is provided that such an error occurred.
3. Regarding the replacement of "sealing foil" with the term "composite film for sealing," Applicant point to p2, paragraph 2 for support of the amendment. Although the cited paragraph recites a "composite structure," the examiner disagrees that this provides support for a "composite film for sealing." The composite structure specifically results in a sealing foil (p2, paragraph 2), not a film.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jud et al. (US 2001/0031348) in view of Bergk et al. (US 4,092,202).

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6. Jud et al. (hereafter Jud) disclose a composite film having a successive layers of polyester, aluminum foil, polyamide, and polypropylene [0002; 0009-12]. Each layer can be attached via adhesive, bonding agents, or a primer [0002]. Jud also discloses another embodiment of a composite film having a substrate **5**, primer **7**, metal foil **1**, adhesive **8**, polyamide layer **3** and a functional layer **2** [0053; Fig. 1]. Each of the layers is bonded through an adhesive layer [0002; claim 9]. Such an adhesive layer corresponds to Applicant's "compatibility layer" as presently claimed.

7. The metal foil would inherently prevent "the migration of components of the primer layer."

8. Jud is silent with regard to a cross-linking two component primer.

9. Such adhesives were well-known in the art, however. For example, Bergk et al. disclose a cross-linking two component adhesive suitable for use with aluminum foils (col 12 ln 35-45). The composites made therefrom possess qualities such as heat resistance (col 1 ln 9-23).

10. At the time of the invention, it would have been obvious to one of ordinary skill in the art to use a two component cross-linking adhesive as the primer layer in Jud's composite film to arrive at a film with good heat resistance.

11. Regarding claim 5:

12. The examiner notes the claim is written in a product-by-process format. Even though Jud is silent with regard to coextrusion, the examiner takes the position that the film would be the same as one that was formed through coextrusion. Further, Jud clearly provides support for extruding various layers [0006; 0008] and coextrusion was a well-known process at the time of the invention. Therefore, it would have been obvious to one of ordinary skill to create the layers via coextrusion for its simplicity.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

14. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the

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specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

15. The substitute specification filed 10 April 2008 has not been entered. Therefore, the recitation of a "composite film for sealing" and "high density polyethylene" found in the present claims constitutes new matter. The term "composite film for sealing" is much more broad than the original term "sealing foil." Furthermore, "high density polyethylene" is not supported by "polyethylene of increased density" as originally filed.

Response to Arguments

16. Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

17. Applicant asserts Jud does not teach or suggest a primer layer. As noted in the original rejection, Jud specifically provides for a primer layer **7** to be used.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Freeman whose telephone number is (571)270-3469. The examiner can normally be reached on Monday-Friday 7:30-5:00PM EST (First Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571)272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Freeman
Examiner
Art Unit 1794

/John Freeman/
Examiner, Art Unit 1794

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794